

REMARKS

Claims 27 through 47 and 53 through 58 are pending in this Application. Claims 48 through 52 have been cancelled without prejudice or disclaimer, claims 27, 33, 34, 40, and 41 though 47 have been amended, and new claims 53 through 58 have been added. Care has been exercised to avoid the introduction of new matter. Adequate descriptive support for the present Amendment should be apparent throughout the originally filed disclosure as, for example, ¶¶ [0049] through [0054], [0076] of the corresponding US Pub. No. 2005/0004968. Applicants submit that the present Amendment does not generate any new matter issue.

Claim Objection.

The Examiner objected to claims 42 through 47 as duplicates of claims 35 through 40, and courteously suggested these claims were likely intended to depend from claim 41. In response, the informality has been corrected as suggested by the Examiner. Accordingly, withdrawal of the objection to claims 42 through 47 is solicited.

Objections to the disclosure.

The Examiner objected to the disclosure for lacking a description of the subject matter recited in claims 31, 38, 45, and 50. This objection is traversed for the reasons set forth *infra* in traversing the corresponding rejection under the first paragraph of 35 U.S.C. §112 for lack of adequate descriptive support and, hence, withdrawal thereof is solicited accordingly.

Claims 31, 38, 45, and 50 were rejected under 35 U.S.C. §112, first paragraph, as failing to comply with the written description requirement.

In stating the rejection, the Examiner asserted that the recitations to: “facilitate discovery of services offered by the mobile server via a registry of services; determine a request parameter contained in the information request that facilitates correct response interpretation; and respond via the common gateway interface based on an interpretation of the request parameter” are not disclosed in the specification. This rejection is traversed.

Initially, literal support is not required by the statute. *Univ. of Rochester v. G.D. Searle & Co.*, 358 F.3d at 923; *Regents of the Univ. of Cal. v. Eli Lilly & Co.*, 119 F.3d 1559, 1566-67 (Fed.Cir.1997). An applicant need not utilize any particular form of disclosure. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008) (quoting *In re Alton*, 76 F.3d 1168, 1172 (Fed.Cir.1996)). Further, a patent applicant has the right to narrow an originally disclosed invention. *In re Johnson*, 558 F.2d 1008 (C.C.P.A. 1977)

Applicants respectfully contend that the originally-filed disclosure, referring to the corresponding publication US Application, fully supports the above-noted claim recitations. Specifically, it is stated in ¶ [0027] of the written description of the specification that “the Web services provided by **the mobile information server** of the present invention provides sets of services and information over the Internet and the Mobile domain to appropriate service consumers. ... The Web services are not specific to any particular mobile terminal platform and they are offered in a manner that allows: 1) discovery of the mobile services/information offered by the mobile server; 2) interpretation of the service/information offerings from a registry of services; and 3) invocation of service/information requests with the appropriate request parameters that facilitates correct response interpretation.” Clearly, the written description of the specification explicitly states that the mobile information server performs the steps recited in claim 31.

It is therefore apparent that one having ordinary skill in the art would clearly understand from the originally-filed disclosure that Applicants had possession of the claimed invention at the time of filing. *Carnegie Mellon Univ. v. Hoffmann-La Roche Inc.*, 541 F.3d 1115, 1122 (Fed.Cir.2008). Applicants therefore submit that the imposed rejection under the first paragraph of 35 U.S.C. §112 for lack of adequate written description is not legally viable and, hence, solicit withdrawal thereof.

Claims 42 through 47 were rejected under 35 U.S.C. 112, second paragraph, as being indefinite.

In stating the rejection, the Examiner identified perceived antecedent basis issues for “the computer readable storage medium”. This rejection is traversed.

Initially, Applicants would point out that indefiniteness under the second paragraph of 35 U.S.C. § 112 is a question of law requiring only **reasonable precision** in light of the particular subject matter involved. *Miles Laboratories, Inc. v. Shandon, Inc.*, 997 F.2d 870 (Fed. Cir. 1993). Simply put the mere identification of a perceived literal lack of antecedent basis is not sufficient to trigger the ultimate legal conclusion of indefiniteness under the second paragraph of 35 U.S.C. § 112. *Energizer Holdings Inc. v. International Trade Commission*, 435 F.3d 1366 (Fed. Cir. 2006); *Bose Corporation v. JBL, Inc.*, 274 F.3d 1354 (Fed. Cir. 2001). Moreover, MPEP § 2173.05(e), entitled “Lack of Antecedent Basis,” states: “There is no requirement that the words in the claim must match those used in the specification disclosure,” and “Obviously, ... the failure to provide explicit antecedent basis for terms does not always render a claim indefinite.” MPEP § 2173.02 states: “Some latitude in the manner of expression and the aptness

of terms should be permitted even though the claim language is not as precise as the examiner might desire.”

At any rate, in order to expedite prosecution, claims 42 through 47 have been clarified by being made dependent upon claim 41, thereby addressing the issue raised by the Examiner and overcoming the stated basis for the rejection. Accordingly, withdrawal of the rejection to claims 42 through 47 under the second paragraph of 35 U.S.C. 112 is solicited.

Claims 27 through 30, 32, 34 though 37, 39, 41 through 44, 46, 48, 49, and 51 were rejected as obvious under 35 U.S.C. §103(a) based on *Yamaguchi* (US 6,980,826, “*Yamaguchi*”) in view of *Wesinger, Jr. et al.* (US 5,778,367, “*Wesinger*”) and further in view of *Bork et al.* (US 6,246,376, “*Bork*”).

In stating the rejection, the Examiner asserted that one having ordinary skill in the art would have been led to modify the communication system of *Yamaguchi* by including a wireless connection to the proximate external device of *Bork*, to allow a mobile terminal user to move about freely while connecting to a GPS device. Still not there, the Examiner further concluded that that one having ordinary skill in the art would have been led to modify whatever system and method can be said to have been reasonably suggested by the combined disclosures of *Yamaguchi* and *Bork* by including a transmitting request/response via a common gateway interface according to *Wesinger*, in order to supply data using a standard-based server extension. Applicants respectfully traverse this rejection.

Specifically, claims 48, 49 and 51 have been cancelled without prejudice or disclaimer. Independent claims 27, 41, and 47 have been clarified by reciting , *inter alia*, “the mobile server is a mobile terminal, the external device is another mobile terminal, and the mobile terminals

exchange call data and content data simultaneously and in real time, while each of the mobile terminals is making a call to each other and accessing the media content data via internet.”

Applicants respectfully submit that none of the applied references, taken singly or in any combination, disclose or suggest the above-described independent operations of a wireless terminal. Simply put, none of *Yamaguchi*, *Bork*, or *Wesinger* enables two mobile terminals to call and exchange content data at the same time. These references, at best, disclose two mobile terminals calling each other in one context, and the mobile terminals exchanging context data in a different context. There is no disclosed connection between the contexts, let alone that timings their respective occurrences be at the same time.

It is therefore apparent that the applied references, whether taken alone or in combination, and Applicants certainly do not agree that the requisite realistic motivation has been established for combining the applied references, fail to engender a *prime facie* case of obviousness of the claimed subject matter. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, 837 F.2d 1044 (Fed. Cir.1988). Applicants, therefore, submit that the imposed rejection of claims 27 through 30, 32, 34 through 37, 39, 41 through 44, 46, 48, 49 and 51 under 35 U.S.C. § 103 for obviousness based on *Yamaguchi* in view of *Bork* and *Wesinger* is not factually or legally viable and, hence, solicit withdrawal thereof.

Claims 31, 38, 45, and 50 were rejected as obvious under 35 U.S.C. §103(a) based on *Yamaguchi* in view of *Wesinger* and *Bork*, and further in view of a publication entitled “Lesson 5: SOAP, UDDI and WSDL”.

This rejection is traversed.

Specifically, Claim 50 has been cancelled without prejudice or disclaimer. Claim 31 depends from independent claim 27, claim 38 depends from independent claim 34, and claim 45 depends from independent claim 41. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 27, 34, and 41 under 35 U.S.C. § 103 for obviousness based on the combined disclosures of *Yamaguchi*, *Bork* and *Wesinger*. The additional publication reference does not cure the previously argued deficiencies in the attempted combination of *Yamaguchi*, *Bork* and *Wesinger*. Accordingly, even if the applied references are combined as proposed by the Examiner, and Applicants do not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicants, therefore, submit that the imposed rejection of claims 31, 38, 45, and 50 under 35 U.S.C. § 103 for obviousness predicated upon *Yamaguchi*, *Bork*, and *Wesinger* in view of the publication is not factually or legally viable and, hence, solicits withdrawal thereof.

Claims 33, 40, 47, and 52 were rejected as obvious under 35 U.S.C. §103(a) based on *Yamaguchi* in view of *Wesinger* and *Bork*, and further in view of *Awada et al.* (US 6,873,861, “*Awada*”).

This rejection is traversed.

Specifically, claim 52 has been cancelled without prejudice or disclaimer. Claim 33 depends from independent claim 27, claim 40 depends from independent claim 34, and claim 47 depends from independent claim 41. Applicants incorporate herein the arguments previously advanced in traversing the imposed rejection of claims 27, 34, and 41 under 35 U.S.C. § 103 for obviousness based on the combined disclosures of *Yamaguchi*, *Bork* and *Wesinger*. The additional reference

to *Awada* does not cure the previously argued deficiencies in the attempted combination of *Yamaguchi*, *Bork* and *Wesinger*. Specifically, at best *Awada* allows the mobile terminals to exchange call data and content data simultaneously (col. 6, lines 21 through 30), but not “when each of the mobile terminals is making a call to each other and accessing the media content data via internet” as recited in the independent claims. The mobile terminal in *Awada* cannot call another mobile terminal while browsing the Internet. In *Awada*, business card information is first downloaded from a database provided by a service provider (col. 5, line 22), saved in the mobile terminal (Step 303 in FIG. 3), and then transmitted to another mobile terminal (Step 317), without overlapping with any internet browsing.

Accordingly, even if the applied references are combined as proposed by the Examiner, and again Applicants do not agree that the requisite basis to support the asserted motivation has been established, the claimed invention would not result. *Uniroyal, Inc. v. Rudkin-Wiley Corp.*, *supra*. Applicants, therefore, submit that the imposed rejection of claims 33, 40, 47, and 52 under 35 U.S.C. § 103 for obviousness predicated upon *Yamaguchi*, *Bork* and *Wesinger* in view of *Awada* is not factually or legally viable and, hence, solicits withdrawal thereof.

New claims 53 through 58.

New claims 53 through 58 depend from claims 27, 34, and 41 and, hence, are free of the applied prior art for reasons advocated *supra* with respect to claims 27, 34, and 41. Further, Applicants separately argue the patentability of claims 53 through 58 based upon the limitations expressed therein.

Claims 53, 55, and 57 recite that “the mobile server is a mobile terminal, the external device is a security access control station controlling access to an area, a user image is captured

by and stored at the mobile terminal, and when in the proximity of the security access control station, the mobile terminal automatically transmits the user image to the security access control station to authenticate the user image thereat independently of human interaction.

Claims 54, 46, and 58 recite that “the mobile server is a mobile terminal, and the external device is a refrigerator that maintains a list of edible items, and the mobile terminal automatically downloads the edible item list to format a shopping list independently of human interaction.

The applied prior art is silent with respect to the limitations in claims 53 through 58. Accordingly, claims 53 through 58 are free of the applied prior art.

Based upon the foregoing, it is apparent that the imposed objections and rejections have been overcome, and that all pending claims are in condition for allowance. Favorable consideration is therefore solicited. If any unresolved issues remain, it is respectfully requested that the Examiner telephone the undersigned attorney at 703-519-9954 so that such issues may be resolved as expeditiously as possible.

To the extent necessary, a petition for an extension of time under 37 C.F.R. § 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 504213 and please credit any excess fees to such deposit account.

Respectfully Submitted,

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